

REMARKS

In the Office Action of July 28, 2003, the Examiner identified four groupings of claims. Group I containing claims 1-10, Group II containing claims 11-16, Group III containing claims 17-22, and Group IV containing claims 23-29. Applicant elects, with traverse, Group I, claims 1-10. Specifically, the Examiner identified claims 1-10 as being drawn to a method for designing an electronic transaction system classified in 705. Claims 11-16 were found to be drawn to a method of forming a proposal for doing business on a global communication network which was also classified in class 705. Claims 17-22 were deemed to be drawn to a method of conducting electronic commerce over a global network which was also classified in class 705. The Examiner then identified claims 23-29 as being drawn to a method of electronic sale of medical devices which was also classified in class 705.

The Examiner concluded that each of the above-identified inventions were distinct from each other because they are "related as subcombinations disclosed as usable together in a single combination." The Examiner simply concluded that "each invention has separate utility such as the electronic sale of automobile parts or other commodity." The Examiner then stated that the restriction is proper simply by stating, without support, that these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification. Applicant respectfully disagreed with the Examiner's conclusion, illustrating that the Examiner failed to meet the burden under the MPEP, CFR, and substantive case law, required to substantiate the restriction, and showed that the Examiner incorrectly classified the Groups.

That is, MPEP §803 provides two separate criteria for a proper requirement for restriction between patentably distinct inventions. Namely, the inventions must be independent or distinct as claimed and there must be a serious burden on the Examiner if restriction is required. MPEP §808.02 sets forth the appropriate guidelines for determining if a serious burden would be placed on the Examiner absent restriction. Specifically, to establish reasons for insisting upon restriction, the Examiner must show by appropriate explanation (1) separate classification of the identified inventions, (2) that the inventions have acquired a separate status in the art, or (3) that the inventions require differing fields of search.

Regarding the Examiner's conclusions as to the separate utility of each of the identified groups, Applicant respectfully believes the Examiner failed to consider the subject matter of the claims of each Group as a whole as well as the similarities and subject matter between each of the identified Groups.

The Examiner cited MPEP §806.05(d) but did not meet the burden required under that section. Specifically, MPEP §806.05(d) is applicable where two or more claimed

subcombinations are usable together in a single combination, and can be shown to be separately usable. MPEP §806.05(d) requires that “[t]he examiner must show, by way of example, that one of the subcombinations has utility other than in the disclosed combination.” However, the Examiner merely stated that “Groups I, II or III have separate utility such as the electronic sale of automobile parts or other commodity.” This statement does not “show, by way of example, that one of the subcombinations has utility other than in the disclosed combination.”

It appears that the Examiner simply compared some of the elements of the independent claims rather than the Groups as a whole. That is, the Examiner asserted that Groups I, II, and III have separate utility. However, when reviewing the Groups as a whole, it is apparent that, contrary to the Examiner’s assertions, Groups I, II, and III do not have separate utility as in the electronic sale of automobile parts or other commodities. Specifically, claims 3, 4, 5, 8, and 10 of Group I all call for medical devices/equipment. Similarly, claims 13 and 15 of Group II call for selling medical devices and the delivery of medical devices, respectively. Claims 19 and 20 of Group III also call for selling medical devices and the delivery of medical devices. In the same vein, claim 23, of Group IV, calls for “a method of electronic sale of medical devices.” Therefore, when the subject matter of the claims of each Group as a whole is reviewed, Groups I, II, and III do not have separate utility as the electronic sale of automobile parts or other commodity. As such, the Examiner clearly failed to meet the burden under MPEP §806.05(d). Therefore, Groups I, II, III, and IV have not been shown to be independent or distinct. As such, Groups I, II, III and IV necessitate rejoinder.

Nevertheless, even assuming arguendo that Groups I, II, and III do have separate utility, the Examiner failed to show that Group I has separate utility from Groups II and III and that Group II has separate utility from Group III. The Examiner’s analysis is superficial, incomplete, and conclusionary. As such, the Examiner did not meet the requirements of MPEP §806.05(d). Therefore, a restriction of Groups I, II, and III is improper. In fact, the Examiner failed to address Groups I, II, and III as separately distinct in any way. Simply, the Examiner did not shown that the inventions are independent or distinct as claimed. Accordingly, assuming that Groups I, II, and III are distinct from Group IV, Groups I, II, and III are not distinct from each other. At a minimum, Groups I, II, and III must be rejoined.

As to whether there is a serious burden on the Examiner if restriction is not required, the Examiner asserts “because these inventions...have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.” However, the Examiner classified each Group in the exact same class – class 705. It appears that the Examiner is hinging the assertion of a serious burden on the subclassification of each Group.

That is, the Examiner classified Group I in subclass 26, Group II in subclass 1, Group III in subclass 7, and Group IV in subclass 36. Specifically, Groups I, II, II and IV were subclassified in the subclass of “electronic shopping (e.g., remote ordering),” “automated electrical financial or business practice or management arrangement,” “operations research,” and “portfolio selection, planning or analysis,” respectively.

Applicant *strongly* questions whether these alleged “distinct” subclassifications are appropriate and, in some cases, even relevant to the present claims. For example, Group I is “a method for designing an electronic transaction system” but is subclassified as “electronic shopping (e.g., remote ordering).” Applicant is uncertain how claims directed “a method for designing an electronic transaction system” acquires separate subclassification from Group II, which is drawn to a method of forming a proposal for doing business on a global communication network” and is subclassified as “automated electrical financial or business practice or management arrangement.”

Additionally, the Examiner stated that Group III is “drawn to a method of conducting electronic commerce over a global network” but subclassified the Group as “operations research.” How is “a method of conducting electronic commerce over a global network” related to “operations research?” Further, how is Group III, “a method of conducting electronic commerce over a global network,” different from Group I, which is subclassified as “electronic shopping (e.g., remote ordering)” or Group II, which is subclassified as automated electrical financial or business practice or management arrangement?”

Similarly, the Examiner stated that Group IV is “drawn to a method of electronic sale of medical devices.” How is a Group IV, “a method of electronic sale of medical devices,” deemed in a subclass for “portfolio selection, planning or analysis?” Further, how is a Group IV, “a method of electronic sale of medical devices,” different from a Group I, which is subclassified as “electronic shopping (e.g., remote ordering)” or Group II, which is subclassified as “automated electrical financial or business practice or management arrangement?” The Examiner’s subclassifications are completely inconsistent. Simply, Group I, II, III and IV have not been shown to be distinct and cannot properly be given different subclassifications.

Applicant does not see a basis for subclassification of any of the Groups in subclasses designated for “electronic shopping (e.g., remote ordering),” “operations research,” and “portfolio selection, planning or analysis.” Due to the similar nature of the claims, as exemplified by the common classification, Applicant does not see any basis for asserting that without restriction a search of all Groups would constitute a serious burden. In fact, the claims and the Groups are so inter-related that Applicant questions how the Examiner could not do the very same breadth of

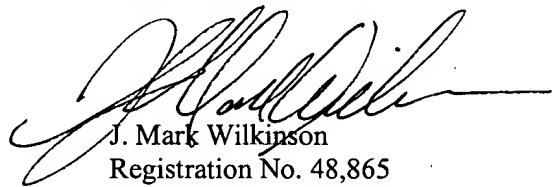
search for each, regardless of subclassification for a thorough examination. Anything less, would appear to be inadequate.

Nevertheless, the Examiner states that "[b]ecause these inventions are distinct for the reasons given above and the search required for Groups I, II or III is not required for Group IV." However, the Examiner provided no support for this assertion. As previously stated, it appears that the Examiner's basis for distinction between Groups I, II, and III from Group IV is that the preamble of Group IV calls for "electronic sale of medical devices." However, Applicant has previously pointed out that the Examiner must consider the Groups as a whole and the specific elements/limitations contained therein. The Examiner cannot just compare preambles of the independent claims. As shown, claims 3, 4, 5, 8, and 10 of Group I all call for medical devices/equipment; claims 13 and 15 of Group II call for selling medical devices and the delivery of medical devices, respectively; and claims 19 and 20 of Group III also call for selling medical devices and the delivery of medical devices. Therefore, a search of the subject matter of Group IV will necessarily include a search of the subject matter of Groups I, II, and III.

Applicant believes Groups I, II, III and IV must be rejoined because the Examiner has not shown: (1) separate classification of the identified inventions, (2) that the inventions have acquired a separate status in the art, and/or (3) that the inventions require differing fields of search. Specifically, the Examiner has made no attempt to meet the requirements for restriction between Groups I, II and III. Therefore, Groups I, II, and III must be rejoined. Furthermore, Applicant has shown that the restriction of Group IV is also improper. Therefore, Applicant requests rejoinder and examination of Groups I, II, III, and IV.

Applicant appreciates the consideration of these Remarks and cordially invites a call to the undersigned, should such be deemed beneficial.

Respectfully submitted,


J. Mark Wilkinson
Registration No. 48,865
Direct Dial 262-376-5016
jmw@zpspatents.com

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P.O. ADDRESS:
Ziolkowski Patent Solutions Group, LLC
14135 N. Cedarburg Rd.
Mequon, WI 53097-1416
262-376-5170